

Appl. No.: 09/990,570  
Amdt. dated December 8, 2008  
Reply to Office Action of August 6, 2008

## **REMARKS/ARGUMENTS**

Claims 1-24 are currently pending in this application.

As an initial matter, the oath is objected to as defective because it does not claim foreign priority. However, there is no requirement that the oath contain a claim to foreign priority in all cases. Foreign priority was claimed in the originally filed documents and was acknowledged by the Office in the filing receipt.

Claims 1-24 stand rejected as being based upon a defective reissue oath under 35 U.S.C. 251. The oath is objected to because it does not claim foreign priority. Under 37 CFR §1.63(c)(2), an oath filed as part of a non-provisional application must include a claim for priority to a foreign application and must identify the application number, country, day, month, and year of filing. According to 37 CFR § 1.67(a)(3), a deficiency in a filed oath due to a failure to meet any of the requirements of 37 CFR §1.63(c) may be corrected through the submittal of an application data sheet. Therefore, an application data sheet is hereby submitted to confirm the foreign priority claim as well as to identify the foreign application, country, and date of filing of the priority document. Applicants respectfully submit that submittal of the application data sheet overcomes the noted deficiency in the oath and respectfully request reconsideration and withdrawal of the rejection based on the defective oath.

Claims 1-24 are further rejected under 35 U.S.C. 103(a) as being unpatentable over the publication "Weeds" (1991) by Harr et al. in view of U.S. Patent No. 5,336,662 to Lee and U.S. Patent No. 4,824,475 to Markley et al. Applicants respectfully traverse this rejection.

Although each reference generally discusses combinations of herbicides, Applicants respectfully submit that the specific combination of dimethenamid with a second herbicide selected from the group consisting of triketone or dione and triazine herbicides claimed in the present invention is not *prima facie* obvious. There is no suggestion or motivation in any of the

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cited references to combine the teachings of these references. Furthermore, one of skill in the art would not be motivated to utilize this particular combination of herbicides without the teachings of the present application. As a result, Applicants respectfully request reconsideration and withdrawal of this rejection.

Although Applicants respectfully disagree with this rejection, to expedite prosecution, applicants enclose herewith a declaration under 37 C.F.R. §1.132 by Bernd Sievernich, an expert at BASF in the area of agronomy. The declaration contains data showing that the combination of dimethenamid and mesotrione, a trione herbicide which is structurally similar to the compounds in Claim 4, exhibits surprising synergistic effects on various crops. The obviousness rejection of the present invention should be overcome by the clear evidence in the declaration of surprising results associated with the claimed invention.

In particular, Mr. Sievernich describes greenhouse experiments performed to test the responses of different plant types to the herbicide combination. You will note from the data presented in Table 1 that application of the herbicide combination resulted in greater activity against all types of plants tested than that expected if the activity of the individual active compounds were simply additive. Thus, the data indicates that the combination treatment of dimethenamid and the trione herbicide mesitrione exhibits synergistically enhanced herbicidal action, an unexpected result.

Further support for surprising synergistic effects resulting from the combination of these types of herbicides is present in the specification. Specifically, Example 4 also describes synergistic effects associated with combinations of herbicides within the scope of the claimed invention. As noted in the specification, this combination of compounds exhibited a synergistic herbicidal effect. Accordingly, even assuming a *prima facie* obviousness rejection has been made, the evidence of record overcomes this rejection. Based on this data and the data presented in the declaration of Mr. Sievernich, Applicants respectfully request reconsideration and withdrawal of the rejection.

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Finally, Claims 1-24 have been rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,716,901 in view of U.S. Patent No. 5,336,662 and as being unpatentable over claims 1, 4, 7, and 9 of U.S. Patent No. 5,900,388 in view of U.S. Patent No. 5,336,662 and U.S. Patent No. 4,824,475. To overcome these rejections, terminal disclaimers directed to the '901 patent and the '388 patent in compliance with 37 CFR 1.321(c) have been provided with this amendment. Applicants respectfully submit that these terminal disclaimers obviate the obviousness-type double patenting rejections for Claims 1-24.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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